

REMARKS

I. Status of the Claims

Claims 1-18 and 24-27 were pending in the subject application. With this submission, claim 24 has been amended. No claims have been canceled or newly added. Hence, upon entry of this paper, claims 1-18 and 24-27 will remain pending. Additionally, claims 24-27 will remain under active consideration.

Claim 24 is amended to recite the term “consisting of.” This change is believed to introduce no new matter.

Applicants wish to thank the Examiner for withdrawing the rejection of claims under 35 U.S.C. §112 first and second paragraph as well as 35 U.S.C. §103(e). Applicants also wish to thank the Examiner for entering the IDS submitted on March 23, 2009.

It is acknowledged that the foregoing amendments are submitted after final rejection. However, because the amendments do not introduce new matter or raise new issues, and because the amendments either place the application in condition for allowance or at least in better condition for appeal, entry thereof by the Examiner is respectfully requested.

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

II. Objection to the Drawings

Applicants submitted replacement Figures 5, 9 and 13 in the response filed on March 23, 2009. Figure 5 has been amended to add the label “Densitometric Intensity” to the y-axis. Figure 9 has been amended to more clearly label the x-axis by repositioning the former x-axis labels. Figure 13 has been amended to change the x-axis label of the first bar from “Control” to “No peptide,” to more clearly indicate that the first bar represents data using no peptide, *i.e.*, peptide at a concentration of zero.

Applicants believe that the objection to Figures 5, 9 and 13 has been overcome and respectfully request that the objection be withdrawn and the Examiner acknowledge acceptance of the replacement drawings in the next communication from the Office.

III. Objection to the Specification

Applicants believe the objection to the specification in the Office Action dated June 23, 2009 has been addressed. Applicants kindly request the Examiner to acknowledge that the objection has been withdrawn.

IV. Double Patenting Rejection

Claims 24 and 25 are rejected on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 1-12 of U.S. Pat. No. 7,291,594 (“’594 patent”). (Office Action, at page 3 line 32 – page 4 line 4, at paragraph 11.)

Applicants request that the Office hold this rejection in abeyance until the remaining rejections have been resolved.

V. Claim Rejections Under 35 U.S.C. § 102 by Rinella

Claims 24 and 25 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Rinella, U.S. Pat. No. 6,440,930 (“Rinella ’930”). (Office Action, at page 4 paragraph 13.)

A claim in a patent application is anticipated (*i.e.* , lacks novelty) if all of its elements are present in a **single** reference in the prior art. Thus, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

According to the Office, Rinella ’930 discloses a GLP-1 molecule that is a GLP-1 derivative prepared by the process of acylating a GLP-1 analog. (Office Action, pages 4-5, paragraph 14.) Rinella ’930 discloses the use of the GLP-1 analog only in conjunction with “a hydrophobic preservative, and nicotinamide.” (Claim 1 of Rinella ’930) The Office argues that the term “having” in claim 24 should be “interpreted as **comprising** and therefore the peptide is not limited to the modification recited.” (emphasis added) (Office Action, page 5, lines 11-12.)

To expedite prosecution and without acquiescing to the propriety of the rejection, Applicants have deleted the term “having” from the claims and added the term “consisting

of”, which should render the objection moot. Applicants thus respectfully request withdrawal of the objection insofar as the amendment to claim 24 renders the subject rejection moot.

VI. Claim Rejections Under 35 U.S.C. § 102 by Hayashi

Claims 24 and 25 are rejected under 35 U.S.C. § 102(a) as allegedly being anticipated by Hayashi et al. (JP 2002-299283; October 11, 2002) (“Hayashi ’283”) (Office Action, at page 5 paragraph 15.)

A. Priority Date of JP 2002-299283 Cannot Serve as 35 U.S.C. § 102(a) art

The PCT application WO/2004/037859, is May 6, 2004. Accordingly, this reference is not prior art. We note, however, that the Office is citing JP 2002-299283, which presumably corresponds to WO/2004/037859. But it is not apparent to the applicants what the publication date of the corresponding JP application is. Based on our review of JP 2002-299283, it appears that this patent document does not correspond to WO/2004/037859 because it is entitled “Manufacturing process of semiconducting device.” Therefore, applicants respectfully request that the Office provide us with the correct document that is cited as 102a prior art, so that applicants can further respond to the outstanding rejection.

For at least these reasons, Applicants thus respectfully request withdrawal of the rejections insofar as the amendment to claim 24 renders the subject rejection moot.

CONCLUSION

Based on the foregoing remarks, Applicants respectfully request that the Examiner reconsider all rejections and that they be withdrawn. Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees, which may be required under 37 C.F.R. §§ 1.16-1.17, and to credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

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Respectfully submitted,

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